

REMARKS

Claims 20-22, 25-28, 30-42, and 44-51 were pending in the application. By this paper, claims 20, 35, 40, and 45 have been amended. Reconsideration and withdrawal of the rejections are hereby respectfully solicited in view of the foregoing amendments and the remarks.

Claim Rejections - 35 U.S.C. §103

Claims 20-22, 24-27, 40-42, 45, and 46 have been rejected under 35 U.S.C. §103(a) as obvious over GB 1,211,849 (GB '849) and further in view of Bonikowski et al., U.S. Patent No. 4,221,947 (Bonikowski). Claims 28, 30-39, 44, and 47-51 have been rejected as obvious over GB '849 in view of Bonikowski, and further in view of MacCraven, U.S. Patent No. 4,437,904 (MacCraven). Each of the independent claims 20, 40, and 45 has been amended herein to recite a limitation taken from dependent claim 35. Dependent claim 35 was rejected only upon a combination of all three of the above noted references. Therefore, this response is directed to the combination of all three these references in view of the amendments to the independent claims.

Specifically, independent claims 20 and 40 have been amended herein to recite that the apparatus as claimed includes "a transport track for moving said billet through the apparatus, wherein a section of said transport track is provided with protective gas." The action admits that neither GB '849 nor Bonikowski teaches or suggests such a transport track and protective gas limitation. In view of the rejection of claim 35 based upon a further combination of these two references with MacCraven, MacCraven is relied upon in the action for allegedly teaching this limitation of amended independent claims 20 and 40.

As shown in Fig. 1 of the application and separately described at page 8, paragraph 6, and page 9, paragraph 3, the protective gas 20 is provided in an area which is at least in part in an annealing path 22. Protective gas 20 is thus supplied upstream of the cooling area, whereat a thin oil 34 is used to cool the billets. In the specification of the application, the billet is said to be already partly through the annealing path 30 when it is cooled by the thin oil.

Each of claims 20 and 40 recites a section of the transport track being provided with *protective* gas, not a *cooling* gas as is said to be disclosed in MacCraven. Further, claim 35 as amended depends from claim 20 and recites that the section of the transport track provided

with protective gas is arranged *between* the cold-processing means and *the cooling section*. Thus, the cooling section and the area provided with protective gas are not one in the same. The combination of GB '849, Bonikowski, and MacCraven fails to teach or suggest all of the limitations of independent claims 20 and 40, and further fails to teach or suggest at least the limitation of claim 35 mentioned above.

The rejection as to claims 20 and 40, as well as their corresponding dependent claims, should be withdrawn for at least this reason. The combination of references fails to teach or suggest all of the claim limitations and, thus, a *prima facie* case of obviousness cannot be established.

Method claim 45 has similarly been amended to recite that "the annealing is performed in a protective gas atmosphere." Again, neither GB '849 nor Bonikowski teach or suggest this limitation. Further, MacCraven fails to teach or suggest performing an *annealing step in a protective gas*. MacCraven discloses only *cooling* a billet utilizing a gas or an oil. Therefore, MacCraven also fails to teach or suggest this limitation of claim 45.

As a result, the reference combination fails to teach or suggest all of the limitations of independent method claim 45, and its corresponding dependent claims. The rejection of these claims should be withdrawn in view of the foregoing.

In addition, the applicant reiterates that GB '849 is merely directed to drying aluminum foils, not annealing aluminum billets. No motivation or suggestion is found within GB '849 nor the other two cited references for combining their various teachings in such a way that would lead one having ordinary skill in the art to achieve the invention as presently claimed, or even as previously claimed, prior to incorporating the amendments herein.

CONCLUSION

The claims are in condition for allowance in view of the foregoing amendments and the following remarks. Reconsideration and withdrawal of the various rejections are hereby respectfully solicited.

The examiner is invited to contact the undersigned at the telephone number listed below in order to discuss any remaining issues or matters of form that will place this case in condition for allowance.

A petition for a one-month extension of time and the appropriate fee accompany this paper. No additional fee is believed due at this time. However, the Commissioner is hereby

authorized to charge any fee deficiency, or to credit any overpayments, to Deposit Account No. 13-2855 of the undersigned's firm.

Respectfully submitted,



Bryan J. Lempia
Reg. No. 39,746
MARSHALL, GERSTEIN & BORUN LLP
233 S. Wacker Dr.
6300 Sears Tower
Chicago, Illinois 60606
(312) 474-6300

March 9, 2005